

REMARKS

Applicants have amended the specification to more clearly set forth the claim to priority. As this application was filed prior to November 29, 2000, the time period requirement under 37 CFR § 1.78(a)(2) and (a)(5) for claiming priority does not apply. These changes are not believed to introduce new matter, and entry of this amendment is respectfully requested.

The Examiner has rejected claims 57-62 as anticipated by Anderson (5,571,216), and claims 57 and 61-66 as obvious over Sand (4,976,709) in combination with Anderson.

To expedite prosecution, applicants have amended claim 57 to recite "which is" as suggested by the Examiner. Therefore, applicants request that the examiner withdraw the rejection of claims 57-62 as anticipated by Anderson (5,571,216).

The Examiner's obviousness rejections of claims 57 and 61-67 are based on the Examiner's position that "[i]t would have been obvious to artisan of ordinary skill to employ RF energy in the method of Sand ('709) since this is not critical and these (RF energy and laser energy) are equivalent for tissue heating, as taught by Anderson ('216)." Further to our previous remarks addressing this rejection, applicants submit that it would not have been obvious to artisan of ordinary skill to substitute laser energy, as taught by Sand, with RF energy, because Sand does teach the criticality of the energy source employed, and, in fact, at column 3, lines 11-22 teaches away from using RF energy:

The problem of confining peak temperature to the stroma while maintaining acceptably lower temperatures in the inner and outer adjacent corneal layers is recognized in the prior art. U.S. Pat. Nos. 4,326,529 and 4,381,007, for example, disclose use of radio-frequency heating while irrigating the outer corneal surface with a cooling saline solution. Published reports on the technique, however, note ciliary spasm and fluctuating corneal power (topographic hysteresis) up to two months postoperatively. All patients had stroma scarring after the procedure, and the flattening induced was short lived.

As discussed in *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994):

There is no suggestion to combine... if a reference teaches away from its combination with another source.... A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from

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following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

A person of ordinary skill, upon reading Sand, would be led in a direction divergent from the path that was taken by the applicant, i.e., the path of applying RF thermal energy, since Sand teaches one of ordinary skill to use laser energy rather than RF energy.

Applicants submit that the claims are in condition for allowance.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

February 21, 2006

Phyllis K. Kristal

Phyllis K. Kristal
Reg. No. 38,524

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331